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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,951	10/08/1999	MICHAEL A. ARKES	202143	4073

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GARDNER CARTON & DOUGLAS LLP
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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/414,951

Applicant(s)

ARKES, MICHAEL A.

Examiner

Charles R Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by US 6,178,408 B1 *Copple et al*, already of record.

Regarding Claim 1, *Copple et al* disclose the invention as claimed including in a method for administering an on-line auction for an incentive points redemption facility including a catalog of potential auction items (Col. 6, lines 7-18), and a participant database comprising participant records (Fig. 2, element 210; Col. 4, line 58 to Col. 5, line 22), wherein each participant record includes a participant identifier (Col. 5, lines 3-6) and an incentive point value total available to the participant to bid (Col. 5, lines 13-22), the method comprising the steps of:

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designating, for an auction, a set of auction items from the catalog of potential auction items (Col. 8, lines 7-19, particularly lines 13-15. See also Col. 1, lines 48-51);

providing on-line bid access to the set of auction items by authorized participants, the providing on-line access step comprising for an authorized participant:

retrieving, for on-line presentation at a terminal of the authorized participant, data corresponding to an item from the set of auction items, the data including a description of the item and data relating to a current minimum qualifying bid value for the item (Col. 6, lines 7-24);

receiving, via an on-line computer interface, a bid by the authorized participant for the item (Col. 6, lines 25-38; Fig. 3, connection btw. Elements 310 and 322); and

determining, by reference to an available incentive point value total for the authorized participant, whether the new bid exceeds a point total available to the authorized participant (Col. 5, lines 13-22; Col. 6, lines 7-24);

maintaining at least a high bid for each item in the set of auction items (Col. 6, line 18); and

identifying, upon ending an auction period, a participant corresponding to a highest covered bid by referencing at least the high bid for each item (Col. 6, lines 51-57).

It is also inherent that designation of items for an auction would be performed; such designation would provide a necessary defined set of items for which bidders could compete.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,178,408 *Copple et al* in view of US 5,915,244 *Jack et al*.

Regarding Claim 2, *Copple* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Copple* does not specifically disclose the purchase of additional incentive points through a currency-to-points conversion if available points are insufficient. *Jack* discloses such an interchangeability of currency and incentive points at Col. 3, line 46 to Col. 4, line 55. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a currency-to-points conversion to facilitate purchase of extra points because this would make available to a bidder more points to successfully bid for an item that he or she really wanted.

With respect to Claim 3, *Copple* does not specifically disclose delayed point conversion. It would have been obvious modify *Copple* to delay conversion until the bidder won because this would have avoided the administrative burden of converting points back to currency if the bidder was unsuccessful.

With respect to Claim 4, see the discussion of Claim 5. Further, modification of *Copple* to specify a currency-to-points conversion rate for each sponsor would have been obvious

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because this feature could provide a basis for negotiation between sponsors and one practicing the invention.

Concerning Claim 5, *Jack* discloses specifying a currency-to-points conversion for each auction at Col. 4, lines 49-52.

With respect to Claim 6-8, *Copple* discloses notifying via an automated message delivery process (Col. 6, lines 41-43), a fulfillment service of a delivery request (Col. 6, lines 41-43), the delivery request including an identification of a winning participant (Col. 6, line 46), a delivery address (inherent for delivery), and the auction item for which the winning participant submitted a winning bid (Col. 6, lines 44-46).

With respect to Claim 10, *Copple* discloses that the auction is executed on an Internet connected site at Col. 1, lines 5-18 and Col. 4, line 35+.

Concerning Claim 11, *Copple* discloses authorization to bid at Col. 4, line 53 to Col. 5, line 30.

With respect to Claim 12, *Copple* discloses adjustment of an incentive point total after bidding has closed at Col. 7, lines 1-6.

Regarding Claim 13, *Copple* discloses adjustment of incentive point value totals as set forth above. Further, it would have been obvious to adjust such a total before bidding ended so as to prevent the bidder from "spending" the points twice in different auctions, this avoiding over commitment.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,178,408 *Copple et al* in view of US 6,285,989 B1 *Shoham*, already of record.

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Regarding Claim 9, *Copple* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Copple* does not specifically disclose an auction software kit for executing the steps of an auction. *Shoham* disclose such a kit at Summary of the Invention+. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used an auction software kit such as disclosed by *Shoham* to designate, provide and maintain an incentive auction as disclosed by *Copple* because this would have provided kit advantages as described by *Shoham* at Col. 4, lines 29-34 and set forth below:

What has been missing is a highly versatile toolkit with which to quickly define and deploy a wide range of online markets, in particular markets in the medium to high end, and be able to modify the rules of these market on the fly without needing to engage in a lengthy software development process and service disruption.

It would further have been obvious to use the kit to provide an auction on an intranet of an auction sponsor because this would have provided a convenient place for employees to redeem their incentive points. Also, an auction on the sponsor's intranet would have engendered positive feelings toward the sponsor by participants.

Claims 14-16 and 18-20 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,178,408 *Copple et al* in view of US 6,012,045 *Barzilai et al*, already of record.

Concerning Claim 14, *Copple* discloses the invention substantially as claimed. See the discussion of Claim 1 above. While *Copple* discloses most of the functionality of the invention,

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it does not specifically disclose the apparatus elements that perform those functions. *Barzilai* completes these details as set forth below.

Barzilai disclose:

An on-line auction facility for managing bids of authorized participants (Col. 5, line 19 to Col. 6, line 52) on a set of auction items (Col. 6, lines 38-50), the on-line auction facility comprising:

- an authorized participants database configured to store a set of authorized participant entries (Fig. 2, element 34), each participant entry including a participant identification and an available funds value total (Col. 7, lines 36-60);

- an auction items database configured to store a set of auction item entries corresponding to auction items to be bid upon by authorized participants (Fig 2, ele.38), each auction item entry including an auction item identification and at least a high bid (Col.11, lines 6-30);

- a network communication interface providing on-line access to the auction facilities (Col. 3, line 44 to Col. 5, line 7, particularly Col. 3, lines 57-58);

- an interactive auction server including:

- a participant authenticator for selectively granting access by authorized participants to the contents of the auction items database and to submit bids on items from the auction items database (Col. 5, lines 8-32; Col. 7, line 17 to Col. 8, line 32);

- an auction item display generator, having communicative access to the auction item database, the auction item display generator responding to requests from authorized participants via the network communication interface by retrieving from the auction

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items database, information relating to a selected auction item for display for the authorized participants (Fig. 5; Col. 11, line 37 to Col. 12, line 45);

a bid verifier, having communicative access to the participant points total in the participant database, for determining whether a received bid exceeds an available incentive point value total for an authorized participant (Col. 7, lines 40-60);

and a bid register for maintaining at least a high bid for each item represented in the set of auction item entries Col. 14, lines 10-34.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the apparatus elements disclosed by *Barzilai* to implement the auction functions disclosed by *Copple et al* because the subject matter of auction management was common to both inventions and the inventions were method-apparatus reflections of one another. The use of the apparatus of *Barzilai* would have provided a convenient and effective infrastructure for the execution of the auction steps of *Copple*.

With respect to Claim 15, *Copple* discloses that a participant entry includes contact information at Col. 5, lines 4-22. *Barzilai* discloses the same feature at Col. 7, lines 35-60.

Regarding Claim 16, see the discussions of Claims 14 and 13 above.

With respect to Claim 18, *Barzilai* discloses including a suggested item value at Col. 6, lines 11-62. It would further have been obvious modify *Copple* to provide such a suggested value because this would have provided a reasonable starting price for the auction. Additionally, it would have been obvious to provide a suggested starting price so as to give guidance on what

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price was likely to be accepted. Some guidance for bidding is required from a simply practical point-of-view and is commonly known as an initial bid.

With respect to Claims 19 and 20, see the discussion of Claim 18 and further note the equivalence of currency (dollars) and incentive points as set forth in the discussion of Claim 2.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,178,408 *Copple et al* in view of US 6,012,045 *Barzilai et al* and further in view of US 6,026,383 *Ausubel*, already of record.

Regarding Claim 17, *Copple* discloses the invention substantially as claimed. See the discussion of Claim 14 above. *Copple* does not disclose the inclusion of a bid history including a high bid and list of preceding bids. *Ausubel* discloses this feature at Col. 6, lines 11-62 and Col. 8, lines 20-35. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a bid history as disclosed by *Ausubel* in the invention of *Copple* because this would have allowed bidders to see information necessary to modify their responses after the auction had begun, as specifically noted by *Ausubel* at Col. 8, lines 25-35.

Response to Arguments

Applicant's arguments filed December 30, 2004 have been fully considered but they are not persuasive.

The arguments presented have been considered but are ineffective to overcome the *Copple et al* reference. The evidence previously submitted, and again reviewed by the Examiner is insufficient to establish applicant's alleged actual reduction to practice of the invention in this

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country or a NAFTA or WTO member country before the effective date of the *Copple et al* reference. Applicant has argued that the screen shots provided as evidence are sufficient to swear back of *Copple* and represent the claimed invention. However, the exhibits are screen shots that display information, but do not inherently show that Applicants possessed the claimed invention.

Specifically, Applicant has made no attempt in prior prosecution to map the limitations of Claim 1 and its dependent Claims to the exhibits. Even given the evidence of screen shots, Applicant only shows *display* of particular information, rather than actual execution of method steps. There is no evidence that the recited method steps are executed; only “result” is shown. It is not necessary that the display of the exhibited information requires execution of the recited method steps. An example of evidence of execution of method steps this would be computer listings showing specific code modules to perform each step.

As to Claim 14 and its dependent Claims, Applicant attempted in the July 17, 2003 Response to map exhibit elements to Claim limitations but was ineffective. Certain Claim elements appear, but others are missing. A specific example is useful. At lines 12-14, Claim 14 recites:

a participant authenticator *for selectively granting access by authorized participants to the contents of the auction items database and to submit bids on items from the auction items database,*

Applicant cited sheets 8, 9 and 10 of the Exhibit A to support argument that this limitation was reduced to practice prior to *Copple*. A participant authenticator of sorts is shown. However, the displayed web page fails to provide support for the portion of this limitation

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italicized above. Nowhere on these sheets is shown *selective grant of access by authorized participants to the contents of the auction items database and to submit bids on items from the auction items database.*

For the reasons above, Applicant fails to show reduction to practice prior to the effective date of *Copple*.

Applicant also does not show due diligence from a time before *Copple*'s effective date to Applicant's constructive reduction to practice, the filing date of the application. As set forth in prior actions, Applicant cannot show due diligence during this period due to the level of evidence presented. Applicant presents several screen shots, which again disclose display of information but do not provide evidence of functionality and/or lack evidence of claim limitations. Applicant provides no evidence of ongoing effort during the period such as dated notebooks or print outs of computer code listings. Evidence of this detail is common practice in other arts such as chemical research and can provide a basis for diligence.

MPEP 2138.06 sets out clear requirements for an Applicant to meet to show diligence. Applicant has not met this burden. This section of the MPEP set out below gives specific, detailed requirements to be met to provide evidence sufficient to swear behind. Particularly relevant portions are bolded and italicized below:

2138.06 [R-1] "Reasonable Diligence"

The diligence of 35 U.S.C. 102(g) relates to rea-sonable "attorney-diligence" and "engineering-diligence" (Keizer v. Bradley, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that "an inventor or his attorney ... drop all other work and concentrate on the particular invention involved..." Emery v. Ronden, 188

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USPQ 264, 268 (Bd. Pat. Inter. 1974).

CRITICAL PERIOD FOR ESTABLISHING DILIGENCE BETWEEN ONE WHO WAS FIRST TO CONCEIVE BUT LATER TO REDUCE TO PRACTICE THE INVENTION

The critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937) ("lack of diligence from the time of conception to the time immediately preceding the conception date of the second conceiver is not regarded as of importance except as it may have a bearing upon his subsequent acts"). What serves as the entry date into the field of a first reducer is dependent upon what is being relied on by the first reducer, e.g., conception plus reasonable diligence to reduction to practice (*Fritsch v. Lin*, 21 USPQ2d 1731, 1734 (Bd. Pat. App. & Inter. 1991), *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974)); an actual reduction to practice or a constructive reduction to practice by the filing of either a U.S. application (*Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975)) or reliance upon priority under 35 U.S.C. 119 of a foreign application (*Justus v. Appenzeller*, 177 USPQ 332, 339 (Bd. Pat. Inter. 1971) (chain of priorities under 35 U.S.C. 119 and 120, priority under 35 U.S.C. 119 denied for failure to supply certified copy of the foreign application during pendency of the application filed within the twelfth month)).

THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (***statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading***). ***A 2-day period lacking activity has been held to be fatal.*** *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (***Diligence requires that applicants must be specific as to dates and facts.***).

The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2

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USPQ2d 1361 (Fed. Cir. 1987) (*Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.*); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); Tucker v. Natta, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); Justus v. Appenzeller, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....").

WORK RELIED UPON TO SHOW REASONABLE DILIGENCE MUST BE DIRECTLY RELATED TO THE REDUCTION TO PRACTICE

The work relied upon to show reasonable diligence must be directly related to the reduction to practice of the invention in issue. Naber v. Cricchi, 567 F.2d 382, 384, 196 USPQ 294, 296 (CCPA 1977), cert. denied, 439 U.S. 826 (1978). >See also Scott v. Koyama, 281 F.3d 1243, 1248-49, 61 USPQ2d 1856, 1859 (Fed. Cir. 2002) (Activities directed at building a plant to practice the claimed process of producing tetrafluoroethane on a large scale constituted efforts toward actual reduction to practice, and thus were evidence of diligence. The court distinguished cases where diligence was not found because inventors either discontinued development or failed to complete the invention while pursuing financing or other commercial activity.); In re Jolley, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and procurement activities related to the subject matter of the interference count).< "[U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue." Ginos v. Nedelec, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983) (work on other closely related compounds that were considered to be part of the same invention and which were included as part of a grandparent application). "The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter." Gunn v. Bosch, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973) (An actual reduction to practice of the invention at issue which occurred when the inventor was working on a different invention "was fortuitous, and not the result of a continuous intent or effort to

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reduce to practice the invention here in issue. Such fortuitousness is inconsistent with the exercise of diligence toward reduction to practice of that invention." 181 USPQ at 761. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor's circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); *Huelster v. Reiter*, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (if inventor was not able to make an actual reduction to practice of the invention, he must also show why he was not able to constructively reduce the invention to practice by the filing of an application).

As to Applicant's comments regarding Claim 2, Applicant argues that there is no teaching or suggestion in *Jack* to allow purchase of points. *Jack* does teach an interchangeability of currency and incentive points as noted above. Applicant does not address the Examiner's comment that it would be obvious to one of ordinary skill to allow points purchase because this would make available to a bidder more points to successfully bid for an item that he or she really wanted. It is clear that a bidder desiring an item and short of points might think, "I'm short of points and would sure like to buy some to get that item."

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

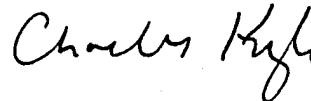
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
March 28, 2005

Examiner Charles Kyle

A handwritten signature in cursive script, appearing to read "Charles Kyle", is written below the printed name.